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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,974	01/18/2001	Hnas-Jurgen Schaschke	PSB 2000/01 (8463*1)	7109

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EXAMINER

JIMENEZ, MARC QUEMUEL

ART UNIT

PAPER NUMBER

3726

DATE MAILED: 06/24/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/764,974	SCHASCHKE, HNAS-JURGEN
	Examiner Marc Jimenez	Art Unit 3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 30 May 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 31-41 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 31-41 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____.

2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

6) Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 31-41** are rejected under 35 U.S.C. 103(a) as being unpatentable over Arlid et al. (3,898,929) in view of Meltz (3,345,942).

Arlid et al. teach a method of using a roller (fig. 2) comprising a roller core **11** and a roller covering **12** being composed of an elastomer or elastic plastic material (col. 3, lines 13-18) comprising the step of running the roller (fig. 2) in a dampening system (fig. 3, col. 4, lines 3-10) of an offset printing machine (col. 1, lines 25-30).

Arlid et al. teach the invention cited with the exception of the elastomer or elastic plastic material containing fluorinated polyolefin.

Meltz teaches a roller with a roller covering **14** composed of an elastomer or elastic plastic material containing fluorinated polyolefin (col. 3, lines 48-61). Note that “polytetrafluoroethylene” or “PTFE” is a fluorinated polyolefin as described in applicant’s specification at page 5, first paragraph, as also described in other U.S. patents such as US 5981656 or 6180702 (see the excerpts taken from these respective patents attached at the end of this office action), and as claimed in applicant’s claim 33.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Arlid et al. with the elastomer or elastic plastic material containing fluorinated polyolefin, in light of the teachings of Meltz, in order to provide a surface that can be easily ground if damaged, will provide a smooth surface with the desired release properties, and to provide a roller that is easier to clean as suggested by Meltz at col. 5, lines 2-8 and lines 21-25.

Note that the polytetrafluoroethylene taught by Meltz is also a fluorocarbon plastic (see applicant's specification at page 5, lines 4-5, the elastomer or plastic material comprises from 0.5 to 25% by weight of the fluorinated polyolefin (see "Example 1" in col. 3-4), the fluorinated polyolefin forms a surface layer (col. 5, lines 4-5), and the fluorinated polyolefin is applied as a powder (col. 5, lines 21-22).

Note that both Arlid et al. and Meltz teach rubber layers as claimed in claim 37. Meltz teaches rubbers made from those in claims 38-39 (see col. 4, lines 36-43 and Example 1).

With respect to claims 40-41, Arlid et al./Meltz teach the invention cited with the exception of using thermoplastic elastomer or castable polyurethane as the elastomer or elastic plastic material.

At the time of the invention, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have used thermoplastic elastomer or castable polyurethane because applicant has not disclosed that using thermoplastic elastomer or castable polyurethane provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform

equally well with either the elastomer or elastic plastic material taught by Meltz or the claimed elastomer or elastic plastic material because either elastomer or elastic plastic material perform the same function of providing a fluorinated polyolefin layer equally as well. Therefore, it would have been an obvious matter of design choice to modify Arlid et al./Meltz to obtain the invention as specified in claims 40-41.

Response to Arguments

3. Applicant's arguments filed 5/30/03 have been fully considered but they are not persuasive.
4. In response to applicant's argument that "The teachings of Arlid and Meltz neither alone nor in combination render the claimed invention (comprising the step of running an elastomer or elastic plastic covered roller in a dampening system) obvious", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, it is noted that Meltz suggests using the roller for a dampening system. In col. 1, lines 46-51, Meltz teaches that the roller could be used wherever rubber covered rollers have been used in the past. The rolling of ink onto printing plates is clearly a dampening system (col. 1, line 50) also demonstrated by Arild et al. (see plate cylinder 19 and coated rollers 37).

5. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

6. In response to applicant's argument that desirability of a modification must be suggested by the prior art, it is noted that at col. 5, lines 2-8 and lines 21-25 Meltz suggests using the claimed roller cover to provide a roller with a smooth surface having the desired release properties and to provide a roller that is easier to clean.

7. Regarding the unexpected results argument, it is noted that attorney arguments cannot take the place of evidence in the record *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965) (see MPEP 716.01(c)). Examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration include statements regarding unexpected results, commercial success, solution of a long felt need, inoperability of the prior art, etc.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Interviews After Final

9. Applicant note that an interview after a final rejection will not be granted unless the intended purpose and content of the interview is presented briefly, in writing (the agenda of the interview must be in writing) to clarify issues for appeal requiring only nominal further consideration. Interviews merely to restate arguments of record or to discuss new limitations will be denied. See MPEP 714.13 and 713.09.

Contact Information

10. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information. M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies

of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, or fax (703) 872-9301 or by email to CustomerService3700@uspto.gov.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number is **703-306-5965**. The examiner can normally be reached on **Monday-Friday, between 5:30 am- 2:00 pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 308-6789 or (888) 786-0101
Assignment Branch	(703) 308-9723
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Petitions/Special Programs	(703) 305-9285
Terminal Disclaimers	(703) 305-8408
PCT Help Desk	(703) 305-3257

If the information desired is not provided above, or a number has been changed, please call the general information help line below.

Information Help line 1-800-786-9199
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MJ
June 20, 2003

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